

REMARKS

Claims 11-24 are pending in the application.

Claims 11-24 had been rejected.

Claims 1-10 had been previously cancelled without prejudice.

Reconsideration of the Claims is respectfully requested.

1. Rejection under 35 USC § 112, ¶ 2

The Office Action rejected claims 13-14 and 20-21 under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action stated that the claim scope was uncertain since a trademark or trade name cannot be used properly to identify any particular material or product.

“The presence of a trademark or trade name in a claim is not, *per se*, improper under 35 U.S.C. 112, second paragraph but the claim should be carefully analyzed to determine how the mark or name is used in the claim.” MPEP 2173.05(u) at p. 2100-207. Applicant respectfully submits that the Office Action incorrectly takes the position that the use of a certification mark, which is distinguishable from a trademark or trade name, is *per se* improper, even though the term is used, for example, to indicate that “the host-side wireless interface supports at least one version of the Bluetooth operating standard.”

The term “Bluetooth” is registered in the U.S. Patent & Trademark Office as a certification mark (see TM Reg. No. 75643769). In law, a certification mark is one which is “used by a person other than its owner, . . . to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services” TMEP § 1306.01(b) (“Definition of Certification Mark”) (emphasis added); see also 37 CFR § 2.45. The Green reference was based upon an earlier Office Action that relied upon the misplaced statement that Bluetooth is a trademark owned by Ericsson. (see Final Office Action at p. 7).

The term or “Universal Serial Bus” or its acronym “USB” does not appear to be registered in the U.S. Patent & Trademark Office as a trademark, a trade name, a service mark, or even as a certification mark.

Applicant respectfully submits that the term “Bluetooth,” along with the term “USB,” serves as a name used in trade. That is, as “a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public, generally.

Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.” MPEP 608.01(v) (rev. 2, May 2004).

Such terms are permitted in patent applications where, in the United States and its territories, “their meanings are well-known and satisfactorily defined in the literature.” MPEP 608.01(v) (*see, e.g.*, Green (US Patent No. 6,519,290) at Claim 10 (“The apparatus according to claim 1, wherein said circuit includes a Bluetooth wireless network device.”)). The Applicant had provided hyperlinks in its prior response as examples of the defined specifications. Further, as permitted under Federal Law, such language takes into consideration the backwards-compatibility with respect to the “Bluetooth operating standard,” and as permissible, addresses foreseeable alteration of Applicant’s claimed structure. *See generally* MPEP 2181 at p. 2100-219 (citing *Sage Prods. Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997)).

Accordingly, Applicant respectfully submits that claims 13-14 and 20-21 comply with 35 U.S.C. § 112, second paragraph, and requests the rejection to these claims be withdrawn.

2. Rejection under 35 USC § 102

For establishing anticipation, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim.” MPEP § 2131 at p. 2100-73 (Rev. 3, August 2005) (citations omitted).

Claims 11, 15, 17-18, 22, and 24 were rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 5,854,621 by Junod et al. (“Junod”).

Junod recites a “radio frequency, wireless video display cursor pointing devices such as mice or trackballs.” (Junod Col. 1:15-16). The mice or trackball devices of Junod “includes unidirectional communication between the mouse and the receiver.” (Junod Col. 2:63-64).

The host adaptor of Junod, on power-up “first detects what type of interface 610 it is using to communicate with the host system 30, i.e. serial or PS/2.” (Junod Col. 8:28-31). The unidirectional transmission mouse communicates with the host adaptor 20 via reports, in which there are “three types of reports . . . displacement and switch information reports, status reports, and channel change request reports.” (Junod Col. 7:31-34). Following the determination of its interface type with the host system, “the CPU [of the host adaptor 20] determines the correct [mouse] identification code by latching onto the

identification code in the first received report and storing it in the [host adaptor] EEPROM 620.” (Junod Col. 9:12-15). That is, the configuration information of the unidirectional wireless mouse of Junod is not stored in non-volatile memory during a configuration operation that can be retrieved and used in servicing the at least one wireless user input device during a subsequent boot mode operation.

In contrast, Applicant’s claim 11 recites, *inter alia*, a “host-side wireless interface that services a host computer and at least one wireless user input device, the host-side wireless interface comprising: a host interface that operably couples to the host computer; . . . a wireless network interface operably coupled to the processing unit and to the host interface that wirelessly couples the host-side wireless interface to the least one wireless user input device; wherein during a configuration operation, configuration information from the at least one wireless user input device is stored in the non-volatile memory and is also transferred to the host computer via the host interface; and during a subsequent boot mode operation, the configuration information is retrieved from the non-volatile memory and used in servicing the at least one wireless user input device.” (emphasis added).

Claim 18 recites, *inter alia*, a “computer system comprising: a host computer; at least one wireless user input device; and a host-side wireless interface that includes: a host interface that operably couples to the host computer; a processing unit operably coupled to the host interface; . . . and a wireless network interface operably coupled to the processing unit and to the host interface that wirelessly couples the host-side wireless interface to the least one wireless user input device; wherein during a configuration operation, configuration information from the at least one wireless user input device is stored in the non-volatile memory and is also transferred to the host computer via the host interface; and during a subsequent boot mode operation, the configuration information is retrieved from the non-volatile memory and used in servicing the at least one wireless user input device.” (emphasis added).

Accordingly, Applicant respectfully submits that each and every element as set forth in its Claim 11 and Claim 18, as for example the underlined portions, is not found in Junod. Applicant submits that Independent Claim 11 and Claims 12-17 that depend therefrom, and Independent Claim 18 and Claims 19-24 that depend therefrom, are allowable. Applicant respectfully requests withdrawal of the rejections to these claims.

3. Rejection under 35 USC § 103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142, p. 2100-134 (Rev. 3, May 2005) (citations omitted).

The Office Action rejected claims 11-24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,782,245 by Lazzarotto et al. ("Lazzarotto") in view of Junod.

Lazzarotto recites "a communication hub that couples a wireless peripheral with a universal serial bus (USB) configured device. The USB configured device may be, for example, a USB-enabled host computer system. The communication hub includes a wireless peripheral interface." (Lazzarotto Col. 2:41-45).

Claims 12 through 17 depend from Independent Claim 11. Claims 19 through 24 depend from Independent Claim 18. In that Junod does not provide a basis for anticipation of Applicant's Independent Claim 11 and Independent Claim 18, the inclusion of the hub-device of Lazzarotto does not provide the elements lacking in Junod such that the hypothetical combination still does not provide teach or suggest all of Applicant's claim limitations.

Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established, and that its Independent Claim 11 and Claims 12-17 that depend therefrom, and its Independent Claim 18 and Claims 18-24 that depend therefrom, are allowable. Applicant respectfully requests withdrawal of the rejections to these claims.

4. Conclusion

As a result of the foregoing, the Applicant respectfully submits that Claims 11-24 in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ksmith@texaspatents.com.

Appl. Serial No. 10/609,060
Response dated July 20, 2006
Reply to Office Action mailed April 20, 2006

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126 (BP 2859).

Respectfully submitted,

Date: July 20, 2006

/Kevin L. Smith/
Kevin L. Smith, Reg. No. 38,620
Attorney for Applicant

Garlick Harrison & Markison
P.O. Box 160727
Austin, TX 78716-0727
(972) 772-8836/office
(972) 772-5033/facsimile

CUSTOMER NUMBER: 51,472